

NICC STANDARDS LIMITED (NICC)

NICC IPR Policy – Issue 3

1 Introduction

The Board has adopted this policy (this **IPR Policy**) to clarify the position in respect of IPRs which may be included in a Standard.

2 Definitions

Paragraph 14 contains definitions of certain terms and expressions used in this IPR Policy.

3 ETSI IPR Policy

This IPR Policy was originally developed from the ETSI IPR Policy. In the event of a change in the ETSI IPR Policy, the Board shall consider appropriate changes to this IPR Policy.

4 Policy Objectives

- 4.1 It is NICC's objective to create Standards that are based on solutions which best meet the technical objectives of the UK telecommunications sector. In order to further this objective, this IPR Policy seeks to reduce the risk to NICC, Members and others applying Standards, that investment in the preparation, adoption and application of Standards could be wasted as a result of an Essential IPR for a Standard being unavailable. In achieving this objective, this IPR Policy seeks a balance between the needs of standardisation for public use in the field of telecommunications and the rights of the owners of IPRs.
- 4.2 IPR holders whether Members and their Group Companies or third parties, should be adequately and fairly rewarded for the use of their IPRs in the implementation of Standards.
- 4.3 NICC shall take reasonable measures to ensure, as far as possible, that its activities enable Standards to be available to potential users in accordance with the general principles of standardisation.

5 Declaration of Essential IPR

- 5.1 Subject to paragraphs 5.2 and 5.3, each Member and each Non-Member participating in a particular Working Group shall use its reasonable endeavours, in particular during the development of a Standard where it participates, to make a declaration in a timely fashion to NICC of any of its Essential IPR which is or might be applicable to the Standard under development. In particular, a Member or Non-Member participating in a Working Group who submits a technical proposal for a Standard shall, on a bona fide basis, declare to NICC (via the chairman of the particular Working Group) to any IPR of that Member or Non-Member which either is or might be Essential if that proposal were to be adopted. The form of **Declaration of Essential IPR**, which comprises Annex A to this IPR Policy, must be used for making this declaration.
- 5.2 Paragraph 5.1 shall not apply in respect of an Essential IPR which has previously been declared:
- (a) to ETSI in accordance with the ETSI IPR Policy and which has been the subject of an undertaking given by its owner in writing that it is willing to grant irrevocable licences on fair, reasonable and non-discriminatory terms and conditions in respect of such IPR to at least the extent provided for in the ETSI IPR Policy; or
 - (b) to the ITU in accordance with the ITU IPR Policy and which has been the subject of a

declaration of willingness by the owner that it is willing to grant licences on a non-discriminatory basis on reasonable terms and conditions at least to the extent provided for in the ITU IPR Policy.

- 5.3 The obligations in paragraph 5.1 do however not imply any obligation on NICC, Members or Non-Member participants in a Working Group to conduct IPR searches.
- 5.4 On receipt of a Declaration of Essential IPR, the procedures set out in Annex B to this IPR Policy shall be followed.

6 Availability of Licences

6.1 When an Essential IPR relating to a particular Standard is declared to NICC and if the declaration does not already do so, the Board shall immediately request the owner to give within three months an undertaking in writing that it is prepared to grant irrevocable licences on fair, reasonable and non-discriminatory terms and conditions in respect of such Essential IPR to at least the following extent:

- (a) Manufacture, including the right to make or have made customized components and sub-systems to the licensee's own design for use in Manufacture;
- (b) sell, lease, or otherwise dispose of Equipment so Manufactured;
- (c) repair, use or operate Equipment; and
- (d) use Methods.

The above undertaking may be made subject to the condition that those who seek licences agree to reciprocate.

6.2 As long as the requested undertaking of the IPR owner is not granted, the Working Group Chairman should, if appropriate, in consultation with the Board use his judgment as to whether or not the Working Group should suspend work on the relevant parts of the Standard until the matter has been resolved and/or submit for approval any relevant Standard.

7 Non-availability of Licences

7.1 Non-availability of licences prior to the publication of a Standard

7.1.1 Existence of a viable alternative technology

Where prior to the publication of a Standard an IPR owner informs NICC that it is not prepared to license an IPR in respect of a Standard on the terms set out in this IPR Policy, the Board shall review the requirement for that Standard and satisfy itself that a viable alternative technology is available for the Standard which:

- (a) is not blocked by that IPR; and
- (b) satisfies NICC's requirements.

7.1.2 Non-existence of a viable alternative technology

Where, in the opinion of the Board, no such viable alternative technology exists, work on the Standard shall cease, and the Board shall observe the following procedure:

- (a) if the IPR owner is a Member:
 - (i) the Board shall request that Member to reconsider its position; and

- (ii) if that Member however decides not to withdraw its refusal to license the IPR, the Member shall then inform the Board of its decision and provide a written explanation of its reasons for refusing to license that IPR, within three months of its receipt of the Board's request.
 - (b) if the IPR owner is a Non-Member:
 - (i) the Board shall, wherever appropriate, request full supporting details from any Member who has notified NICC that licences are not available on the terms set out in this IPR Policy and/or request appropriate Members to use their good offices to find a solution to the problem; and
 - (ii) where this does not lead to a solution the Board shall write to the IPR owner concerned for an explanation and request ultimately that licences be granted on the terms set out in this IPR Policy.
- 7.1.3 During the process under paragraph 7.1.1 or 7.1.2, the relevant Working Group should in consultation with the Board use its judgment as to whether or not the Working Group should pursue development of the concerned parts of the Standard based on the non-available technology and should look for alternative solutions.

7.2 Non-availability of licences after the publication of a Standard

Where, in respect of a published Standard, NICC becomes aware that licences are not available from an IPR owner on the terms set out in this IPR Policy, that Standard shall be referred to the Board for further consideration in accordance with the following procedure:

- (a) the Board shall request full supporting details from any Member or Non-Member who has complained that licences are not available on the terms set out in this IPR Policy;
- (b) the Board shall write to the IPR owner concerned for an explanation and request that licences be granted on the terms set out in this IPR Policy. Where the concerned IPR owner is a Member, it shall inform the Board of its decision and provide a written explanation of its reasons in case of continuing refusal to license that IPR;
- (c) where the IPR owner refuses the Board's request or does not answer the letter within three months, a resolution shall be put to the vote of the Board to immediately refer the Standard to the relevant Working Group to modify it so that the IPR is no longer Essential;
- (d) where the resolution put to the vote of the Board under paragraph 7.2(c) is not passed by the Board, the Board shall continue to endeavour to seek a solution to the problem. In parallel, the Board may request appropriate Members to use their good offices to find a solution to the problem.

In carrying out the foregoing procedure due account shall be taken of the interest of the enterprises that have invested in the implementation of the Standard in question.

8 Information on IPR by NICC

- 8.1 Any published Standard shall include information pertaining to Essential IPRs which are brought to the attention of NICC prior to such publication.
- 8.2 Where a published Standard incorporates references to or content published by another standards organisation, the published Standard shall include links to the IPR policy and declarations of that standards organisation.

9 NICC ownership of IPRs

- 9.1 All existing copyright relating to the activities of the former Network Interoperability Consultative Committee shall remain as previously vested in either Ofcom or the Crown, as appropriate, and shall not be assigned or otherwise transferred to NICC.
- 9.2 All copyright in any Standard will be vested in NICC with the exception of any such copyright owned by third parties that is identifiable in a Standard, for which NICC shall give due acknowledgement to the relevant third parties.
- 9.3 Subject to paragraph 9.4, the publication of a Standard shall contain the grant by NICC to all Members and to third parties of a non-exclusive right:
- (a) to use and copy and distribute any Standard within their own organisations; and
 - (b) to use any trade mark of NICC for the purpose of design, manufacture and implementation of equipment to the specification contained in a Standard.
- 9.4 At the request of any Relevant UK Body, the Board may resolve to withhold or otherwise restrict the grant by NICC of the rights pursuant to paragraph 9.3.
- 9.5 The Board may resolve to grant to other organisations rights to use, copy and distribute Standards, where it considers this to be consistent with the NICC's objects.
- 9.6 Subject to paragraph 9.7, NICC shall not transfer ownership or control of any of its IPR other than to its wholly-owned subsidiary.
- 9.7 From time to time, NICC shall grant to Ofcom an irrevocable, perpetual, royalty-free and non-exclusive licence to use any of NICC's IPRs (including copyright in any Standard or in the working papers of any Working Group) for any purpose (including the right to sue for infringement of such IPRs and the ability to grant one or more sub-licences of all or any of such IPRs on such terms that Ofcom may deem fit). Such licence (and any sub-licence) shall survive the winding-up or dissolution of NICC.

10 Confidentiality

- 10.1 The proceedings of and information relating to each Working Group (including any sub-committee or sub-working group of a Working Group), including:
- (a) contributions of, and information submitted by, a Member (including by its Working Group representative) (the **Contributing Member**) whether orally, in writing or electronically;
 - (b) meeting agendas and supporting documents, discussions at meetings and meeting minutes (in draft or final form); and
 - (c) all documents and other materials of whatever nature (in draft or final form) produced for the purpose of the Working Group, including draft Standards, policy documents, working papers and technical proposals and specifications,
- (together **Working Group Information**) shall, subject to paragraph 10.2, be kept confidential by NICC and by Members and shall be used only for the purpose of the proceedings and work of that Working Group and of other Working Groups and for NICC internal purposes.
- 10.2 The obligations under paragraph 10.1 shall not prohibit:
- (a) the disclosure of Working Group Information which either NICC or a Member is required to disclose by law, by a court of competent jurisdiction or by any local, national, multinational, governmental or non-governmental authority, statutory

- undertaking, agency or public or regulatory body (whether present or future) which has jurisdiction over NICC or the relevant Member;
- (b) the use or disclosure by NICC or a Member of Working Group Information of the nature described in paragraph 10.1(a) above which either:
 - (i) is in the public domain other than as a result of the unauthorised disclosure by NICC or the relevant Member; or
 - (ii) is in the possession of NICC or the relevant Member free from any restriction as to its use or disclosure;
 - (c) the use or disclosure by a Contributing Member of Working Group Information of the nature described in paragraph 10.1(a) above which comprises the contribution of or information submitted by that Contributing Member and does not include any other Working Group Information;
 - (d) the use or disclosure by a Member or by NICC of Working Group Information of the nature described in paragraph 10.1(a) above:
 - (i) with the prior written consent of the relevant Contributing Member;
 - (ii) which was submitted by the relevant Contributing Member expressly on a non-confidential basis; or
 - (iii) which the relevant Contributing Member subsequently agrees may be treated as non-confidential;
 - (e) the disclosure by NICC or a Member of Working Group Information which the Board approves may be disclosed, subject to such restrictions as to the Working Group Information which may be disclosed and the purpose of such disclosure as specified by the Board; or
 - (f) the use or disclosure by NICC or a Member of Working Group Information, following the publication of the relevant Standard, to the extent to which it which has been incorporated into a Standard.

11 Members' IPRs

NICC acknowledges that, other than copyright in any Standard as referred to in paragraph 9.2, all IPRs created, owned or controlled by any Member shall remain vested in that Member and shall not vest in NICC.

12 Law and Regulation

This IPR Policy shall be governed by the laws of England and NICC and the Members agree to submit to the non-exclusive jurisdiction of the English Courts in respect of any dispute arising under or in connection with this IPR Policy.

13 Breach of this IPR Policy

Any breach of this IPR Policy by a Member shall be subject to potential action against the Member under the Articles, including possible termination of membership of NICC in accordance with the procedure for termination set out in the Articles.

14 Definitions

In this IPR Policy:

- (a) **Articles** means the Articles of Association of NICC as adopted from time to time.
- (b) **BIS** means the Department for Business Innovation and Skills, including any successor Government department.
- (c) **Board** means the board of Directors for the time being of NICC.
- (d) **Electronic Communications Networks** and **Electronic Communications Services** shall have the meanings ascribed to those terms in Section 32 Communications Act 2003.
- (e) **Equipment** means any system, or device fully conforming to a Standard.
- (f) **Essential** as applied to IPR means that it is not possible on technical (but not commercial) grounds, taking into account normal technical practice and the state of the art generally available at the time of standardisation, to make, sell, lease, otherwise dispose of, repair, use or operate Equipment or Methods which comply with a Standard without infringing that IPR. For the avoidance of doubt in exceptional cases where a Standard can only be implemented by technical solutions, all of which are infringements of IPRs, all such IPRs shall be considered Essential.
- (g) **ETSI IPR Policy** means ETSI's Intellectual Property Rights Policy (as amended from time to time).
- (h) **Group Company** in relation to a company means:
 - (i) a company that is its subsidiary; or
 - (ii) its holding company or a subsidiary of such holding company,and a reference to a **holding company** or a **subsidiary** means a holding company or a subsidiary (as the case may be) as defined in section 1159 of the Companies Act 2006 and for the purposes only of the membership requirement contained in sections 1159(1)(b) and (c), a company shall be treated as a member of another company even if its shares in that other company are registered in the name of another person (or its nominee), by way of security or in connection with the taking of security or its nominee.
- (i) **IPR** means any intellectual property right conferred by statute law including applications therefore other than trademarks. For the avoidance of doubt rights relating to get-up, confidential information, trade secrets or the like are excluded from the definition of IPR.
- (j) **ITU IPR Policy** means the common patent policy of the International Telecommunication Union, as amended from time to time.
- (k) **Manufacture** means production of Equipment.
- (l) **Member** means a member of NICC. References in this IPR Policy to a Member shall include references to that Member and its Group Companies.
- (m) **Methods** means any method or operation fully conforming to a Standard.
- (n) **Non-Member** means a person who is not a member of NICC or a Group Company of a member of NICC. References in this IPR Policy to a Non-Member shall include

references to that Non-Member and its Group Companies

- (o) **Ofcom** means The Office of Communications, including any successor organisation with responsibility for regulation of the communications sector in the UK under the Communications Act 2003.
- (p) **Relevant UK Body** means any government department or agency, industry body or other organisation in the UK whose responsibilities and functions are relevant to the interconnection and interoperability in the UK of Electronic Communications Networks and Electronic Communications Services including Next Generation Networks UK, The Centre for the Protection of National Infrastructure, the emergency and security services, BIS, Ofcom (including any successor department, agency, body or organisation of each of them).
- (q) **Standards** means standards, technical specifications, service descriptions, information notes, guidelines, codes of practice and other forms of documentation relating to the interconnection and interoperability in the UK of Electronic Communications Networks and Electronic Communications Services.
- (r) **Working Group** means a Working Group of NICC which is undertaking a particular element of NICC's work programme. For the avoidance of doubt, the term Working Group encompasses (but is not limited to) the Technical Steering Group (TSG), Task Groups and Subject Expert Groups.
- (s) **Working Group Representative** means the representative of a Member on a Working Group.

Annex A : Declaration of Essential IPR

Patent Holder

Legal Name _____
 Company Registration Number _____
 Group Company (if applicable) _____
 Company Registration Number _____

Contact for license application

Name & Department _____
 Address _____

 Tel _____
 Fax _____
 Email _____

NICC Standards activity for which Essential IPR is declared

Work Item _____
 Working Group _____
 Draft ND(s) _____

Licensing declaration

The person named above (the **Patent Holder**) believes that it (or its Group Company specified above) holds granted patents and/or pending applications, whose use may be required to implement the above proposed NICC Standard(s) and hereby declares, in accordance with the NICC Standards IPR Policy: (*tick one*)

- The Patent Holder (or its Group Company specified above) is prepared to grant – on the basis of reciprocity for the above NICC Standard(s) – a free licence to an unrestricted number of applicants on a worldwide non-discriminatory basis to manufacture, use and/or sell implementations of the above NICC Standard(s) documents
- The Patent Holder (or its Group Company specified above) is prepared to grant - on the basis of reciprocity for the above proposed NICC Standard(s) - a licence to an unrestricted number of applicants on a worldwide non-discriminatory basis and on fair and reasonable terms and conditions to manufacture, use and/or sell implementations of the above NICC Standard(s) documents. Such negotiations are for the parties concerned and outside the scope of NICC Standards Limited.
- The Patent Holder (or its Group Company specified above) is unwilling to grant licences on the above terms.

By signing this declaration, the Patent Holder declares that it is authorised to do so by its Group Company specified above.

Words and expressions defined in the NICC Standards Limited IPR Policy have the same meaning in this Declaration.

Patent Information			
Number	Registration Number/Country	Title/Inventor	Status (granted/pending)
1			
2			
3			

Signature

Organisation _____
 Name of authorised person _____
 Title of authorised person _____
 Signature _____
 Place, Date _____

Annex B : Procedures for Committees

- i. On receipt of a Declaration of Essential IPR, the Working Group Chairman must provide a copy of it to the NICC Secretary. Participants in the Working Group must be made aware of the Declaration and its contents.
- ii. The NICC Secretary shall liaise with the Working Group Chairman and the party submitting the Declaration of Essential IPR to ensure it is fully populated.
- iii. The NICC Secretary shall make the Board aware of the Declaration of Essential IPR.
- iv. The NICC Board shall liaise with the party submitting the Declaration of Essential IPR to secure commitment to license the usage of the IPR in accordance with this IPR Policy.
- v. During the Consensus Document Approval Process or Voting Document Approval Process under the Articles for the relevant Standard, the Members must be made aware of the Declaration.
- vi. On publication of the relevant Standard, a copy of the Declaration of Essential IPR will be placed on the public NICC website, in a central repository of IPR declarations. The Standard will provide a link to that central repository.
- vii. For the avoidance of doubt, NICC will make no judgement on the legitimacy of the Declaration; NICC's responsibility will only be to draw the readers' attention to the fact that a Declaration of Essential IPR has been made.